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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,297	07/09/1999	YOSHINORI SHIBATA	99143	7865

34055 7590 07/14/2004

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EXAMINER	
RACHUBA, MAURINA T	
ART UNIT	**PAPER NUMBER**
3723	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/350,297	SHIBATA ET AL.
	Examiner	Art Unit
	M Rachuba	3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *34-46 and 55-59* is/are allowed.

6)☒ Claim(s) *17-21,26-29,47-49 and 51-54* is/are rejected.

7)☒ Claim(s) *22-25, 30-33 and 50* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (f) he did not himself invent the subject matter sought to be patented.
>
> (g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

5. Claims 17-21, 26-29, 47-49 and 51-54 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Please refer to figures 1-5 of Des. 415,942, or figures 1-5 of Des 420,369. It is the examiner's position that '942 discloses the claimed invention, including a battery mounting device disposed on the rear of the handle in the positions claimed, and a rechargeable battery. However, '942 has a different inventive entity, in that Hisashi Higuchi is not listed as an inventor of the pending application. As '942 discloses the same invention with an earlier filing date, the examiner must conclude that Yoshinori Shibata and Junichi Masuda did not invent the claimed subject matter alone. Applicant, in his remarks accompanying the current amendment, states that a Rule 1 .132 declaration by Hisashi Higuchi, a named inventor on the two cited Shibata et al. design patents, explaining that he only contributed to the ornamental features of the design embodiments, was included in the submission. No such declaration has been received.

6. Claims 17-21, 26-29, 47-49 and 51-54 are directed to the same invention as that of commonly assigned Des.415,942 or Des. 420,369. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved. It appears that the invention as claimed was made in this country by another inventor who had not abandoned, suppressed, or concealed it, based on the disclosure by '942 or '369.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

7. Failure to comply with this requirement will result in a holding of abandonment of this application.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 17-21, 26-29, 47-49 and 51-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 (the figures) of U.S. Design Patent No. 415,942 or 420,369 in view of Judge 6,523,447. Although the conflicting claims are not identical, they are not patentably distinct from each other because the design patents both disclose the same structure as claimed by the application. Note that both design patents disclose a table saw with the same structure as that now claimed, as well as the motor (evidenced by the motor casing) and a battery (evidenced by the battery casing). It is not clear or inherent that the battery is a rechargeable battery. '447, in a similar device, teaches providing a table saw with a rechargeable battery. It would have been obvious to one of ordinary skill to have provided '942 or '369 with a rechargeable battery, to lower the cost of providing energy to the tool.

Allowable Subject Matter

12. Claims 34-46 and 55-59 are allowed.

13. Claims 22-25, 30-33 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

1. Applicant's arguments filed February 24, 2004 have been fully considered but they are not persuasive with respect to the rejections under 35 USC 102 (f) or (g).. As

the declaration under 37 CFR 1.132 has not been received, the rejection must be maintained. Regarding the double patenting rejection and the rejection under 35 USC 102(g), applicant argues that the claims pending and those of the design patents (the figures) are not the same, as the claims of the design patent show structure which is not claimed in the utility application. This is convincing, and the double patenting rejection based on 35 USC 101 has been withdrawn.

> MPEP 804 discusses situations where double patenting between utility and design patents and/or applications may be raised:
>
> Double patenting issues may be raised where an applicant has filed both a utility patent application (35 U.S.C. 111) and either an application for a plant patent (35 U.S.C. 161) or an application for a design patent (35 U.S.C. 171). In general, the same double patenting principles and criteria that are applied in utility-utility situations are applied to utility-plant or utility-design situations. Double patenting rejections in utility-plant situations may be made in appropriate circumstances.
>
> Although double patenting is rare in the context of utility versus design patents, a double patenting rejection of a pending design or utility application can be made on the basis of a previously issued utility or design patent, respectively. Carman Indus. Inc. v. Wahl, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983). The rejection is based on the public policy preventing the extension of the term of a patent. Double patenting may be found in a design-utility situation irrespective of whether the claims in the patent relied on in the rejection and the claims in issue involve the same invention, or whether they involve inventions which are obvious variations of one another. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Here, both the design patents '942 and '369 as modified by '447 infringe on the invention set forth in claims 17-21, 26-29, 47-49 and 51-54. For example, claim 17, which limits a table saw corresponds to the table saw claimed in '942, comprising a table (figures 1 and 4-6) adapted to support a workpiece, a saw unit (figures 1, 4 and 5) disposed above the table and pivotable with respect to the table about a pivotal axis

(figures 1, 4 and 5), the saw unit comprising a saw blade (figures 1, 4 and 5), a motor housing (figures 1, 2 and 5) and a blade case covering an uppermost portion of the saw blade (figures 1, 2, 4 and 5), the blade case having a rear portion defined closest to the pivotal axis and a front portion defined furthest from the pivotal axis (figures 1, 2, 4 and 5), a battery-driven motor disposed within the motor housing and adapted to rotatably drive the saw blade, a battery mounting device disposed at the rear portion of the blade case. '447 teaches a rechargeable battery detachably mounted within the battery mounting device.

Conclusion

14. Any inquiry concerning the content of this communication or earlier communications from the examiner should be directed to M. Rachuba whose telephone number is (703) 308-1361. The examiner can normally be reached on Monday through Friday from 8:30 AM to 4:00 PM. Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail, can be reached on (703) 308-2687. The fax phone number for this Group is (703) 872-9302.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

M. RACHUBA
PRIMARY PATENT EXAMINER
ART UNIT 3723

mtr
July 12, 2004